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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/086,229   | 02/27/2002  | Joerg Wurft          | 2020318             | 7795             |
| 34018  | 7590        | 05/04/2004           | EXAMINER            |                  |
| GREENBERG TRAURIG, LLP<br>77 WEST WACKER DRIVE<br>SUITE 2500<br>CHICAGO, IL 60601-1732 |             |                      | BELLINGER, JASON R  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3617                |                  |

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/086,229

Applicant(s)

WURFT, JOERG

Examiner

Jason R Bellinger

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*ML*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### ***Specification***

1. The disclosure is objected to because of the following informalities: In line 2 of substitute paragraph 0001 of the specification, the term "allow" should be replaced with the term --alloy-- to correct a minor typographical error.

Appropriate correction is required.

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities: The phrase "single-part" should be replaced with the phrase --single part-- for grammatical clarity.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite due to the fact that it is unclear what it actually being claimed by the phrase "the spacing disk being formed as a single-part [sic], preferably single-unit, flange-like component." in lines 11-12. It is unclear what the difference is between a "single-part [sic]" spacing disk and a "single-unit" spacing disk, since both of the quoted limitations infer that the element is formed as one piece. The aforementioned

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phrase appears as if it may be some sort of range within a range. It is suggested that the spacing element be referred to as a "single part" or a "single-unit", but not both.

***Claim Rejections - 35 USC § 103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-3 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over English in view of Hummel et al. English shows a magnesium alloy wheel 10 for a motor vehicle (see column 2, lines 54-57). The wheel 10 has a bowl unit 21 with a central area in which attachment borings (or holes) 23 for bolts 16 and a hub bore. The wheel bowl unit 21 further includes a rear, ring-shaped placement area 34 for mounting to a brake element.

While English does not show the wheel being mounted to a disc brake element, however English does show the wheel being mounted to a brake drum 14. Brake drums and brake discs are considered equivalent braking elements that serve the same function.

A spacing disk 28 is provided at the placement area 34 and hub bore. A spacing tube 29 at least partially penetrates the hub bore in the axial direction. The spacing tube 29 and the spacing disk 28 are formed as a single-unit, flange-like component. The spacing disk 28 is provided on the placement area 34 of the wheel bowl unit 21.

English does not show a spacing disk formed from an aluminum alloy, nor the attachment bores having spacing liners provided therein. Hummel et al teaches the use of a spacer unit 21 formed from an aluminum alloy. Hummel et al also teaches the use of spacing liners 7 that penetrate the boltholes of the wheel in the axial direction. These spacing liners 7 are press fit into the bores (see column 2, lines 55-56), and are therefore attached in an unlosable manner to the wheel.

Hummel et al does not specify the type of material that the attachment bore spacer unit 7 is formed from. However, it would have been obvious in the art at the time of the invention to provide the bolt and hub bore spacer units from the same aluminum alloy material as that of the ring-shaped placement area spacer unit 21 for the purpose of reducing the cost of purchasing and machining multiple types of materials, creating a more uniform aesthetic appearance to the wheel, and preventing corrosion between an magnesium alloy wheel and hub of the brake.

Therefore from these teachings, it would have been obvious to one of ordinary skill at the time of the invention to provide the wheel of English with spacer units of an aluminum alloy and spacing liners press fit into the boltholes of the wheel for the purpose of preventing corrosion between the magnesium wheel and brake unit, and to assist in the centering of the wheel on the brake unit.

7. Claim 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over English in view of Hummel et al as applied to claims 1-3 and 6-7 above, and further in view of Maiworm et al. English as modified by Hummel et al does not show the spacing

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disk having penetrating bores through which the spacing liners are guided and connected, nor does English as modified by Hummel et al show the spacing liners having flange edges to form an interlocking connection with the spacing disk.

Maiworm et al teaches the use of a spacing liner 13 having a flange edge 14, wherein the spacing liner 13 is guided into and connected with a spacing disk 10 through penetrating bores 12. Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the spacing disk and spacing liners of English as modified by Hummel et al with penetrating bores and flanged edges, respectively for the purpose of protecting the magnesium wheel from contact with the typically steel or iron axle or hub portion of a brake; thereby preventing corrosion between the wheel and the brake and/or axle, and to provide a more secure interlock between the spacing units.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-3 and 6-9 have been considered but are moot in view of the new ground(s) of rejection.

9. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

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not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R Bellinger whose telephone number is 703-308-6298. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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